

REMARKS

Claims 14-23 are pending in the present application. The objections and rejections are addressed below. Attached is a marked-up version of the changes made to the specification by this amendment. The attached page is captioned "**VERSION WITH MARKINGS TO SHOW CHANGED MADE**".

Written Consent of All Assignees

This application stands objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. Attached is a copy of the consent filed by the assignee in the parent reissue application of which this application is a continuation. See MPEP 1410.01.

Withdrawal of this objection is therefore requested.

Establish Assignee Ownership Interest

This application stands objected to under 37 CFR 1.172(a) on the basis that the assignee has not established its ownership interest in the patent for which reissue is being requested. As noted in MPEP 1410.01, the notation of the reel and frame number reflecting recordation assignment is sufficient for this purpose. That recordation may be found at reel 7509, frames 0452, 0453, and 0454. A copy of the assignment of the original is included even though not necessary in this instance.

Withdrawal of this objection is therefore requested.

Recapture

Claims 14-23 stand rejected under 35 U.S.C. 251 as reflecting an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue application is based.

Assuming, *arguendo*, that claim 14 in the instant application is broader in scope over claim 1 of the surrendered patent 5,563,067. The applicants are legally entitled to assert their statutory rights under 35 U.S.C. § 251 in requesting a reissue of a patent enlarging the scope of the claims of the original patent within the statutory period of two years.

The Office Action contends that the broadened claims are improper recapture. In the guidelines for recapture analysis set forth by the Court of Appeals for the Federal Circuit, the Court specifically required that in addition to an analysis of the claims to determine whether any aspect of the reissue claims are broader than the patented claims, it is incumbent upon the USPTO to demonstrate that the broader aspects of the reissue claims relate to the surrendered subject matter. *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 at 1164 (Fed. Cir. 1997). In addition, the USPTO's guideline also adopts this analysis; specifically, the *Manual of Patent Examining Procedure* (section 1412.02 - Recapture of Canceled Subject Matter) notes: "Where a claim in a reissue application is in fact broadened, the Examiner must next determine whether the broader aspects of that reissue claim relates to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued)." The MPEP further requires that "[e]ach limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination." *MPEP* 1412.02.

The burden of presenting a prima facie case of unpatentability resides with the PTO, as discussed in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In *Henster Industries, Inc. v. Stein, Inc.* (1998) the Federal Circuit held that in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability. Furthermore, in *Clement*, the Court noted that, with regard to claim amendments, **the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable.** Thus, in this instance, the PTO has both the initial burden of producing some factual evidence tending to show that, in the original prosecution, the applicants

had deliberately surrendered the broadened aspects of the claims in the face of indication by the PTO that the claims were unpatentable.

The policy reason behind the reissue statute was enunciated in *Topliff v. Topliff*, 145 U.S. 156, 12 S. Ct. 825 (1892), where the court stressed the obvious intent of the reissue statute to avoid “great hardship” to the inventor patentee and noted that the specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy. The legislatures’ intent to grant specific rights to the patentees in broadening their patent claims, if particular conditions for reissue are met, is clear and unequivocal.

The PTO appears to embrace the tenets found in the various judicial discussions of “prosecution history estoppel” as the basis for determining whether recapture is allowable under the statute. The Federal Circuit’s discussions of prosecution history estoppel as it relates to the Doctrine of Equivalents in, e.g., recent cases such as *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000), seemed to have broadened the reach of prosecution history estoppel. Of course, *Festo* was vacated recently vacated and remanded *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 2002 Lexis 3818, (May 28, 2002). The Supreme Court there stated that such an estoppel may be applied “to a narrowing amendment made to satisfy any Patent Act requirement, ...” Thus even using the harsher and more rigorous standards applied under prosecution history estoppel, the PTO could not show that the amendment made by the Examiner in the parent patent’s application (and agreed to by the applicants’ attorney) would be related in any way to some non-compliance with the Patent Act.

But, even applying the cases relating to the interpretation of prosecution history estoppel to the recapture question is improper. The doctrine of equivalents broadens the reach of the claims beyond the specific words that are used in the claim language. Prosecution history estoppel as applied to the doctrine of equivalents serve to limit that expansion.

Unlike the doctrine of equivalents -- an equitable right given by the court -- the right to broaden claims via a broadening reissue is a specific right given in law. Furthermore, the statute has given to patentees specific rights to broadening claims by amendment of claim language. Here, the issue goes to whether particular words can be used in the claim language and not to the interpretation of claim language through claim construction. Thus, any use of the more rigorous tenets of prosecution history estoppel, when applied through the recapture doctrine against a broadening reissue application, must be narrowly construed. Prosecution history estoppel, as applied to limiting the extent of broadening reissue, has traditionally required that the applicant to "deliberately" have withdrawn or amended a claim in order to obtain a patent. *In re Byers*, 230 F.2d 451, 109 USPQ 53 (CCPA 1956). Now we know that the Patent Act must be considered as well in assessing whether any amendment in the patent's prosecution file was done with the object of complying with the Patent Act. In this case, there is no such proof.

The prosecution history of the '067 patent does not show that the applicant deliberately surrendered any aspects of the claimed invention to comply with a section of the Patent Act, nor is there any indication that a rejection by the PTO was made or even hinted at. In fact, the claims of the patent application were not rejected on any basis during the prosecution of that application. In the absence of any evidence that there was even a rejection for patentee to agree with or to acquiesce in, it is unclear on what basis the Office Action can reasonably assert that the patentees are now attempting improperly to recapture subject matter previously given up during that previous prosecution. The burden rests with the PTO to present factual evidence establishing a *prima facie* case of unpatentability.

In the absence of any factual evidence in the prosecution history of the '067 patent indicating that the applicants had volitionally or intentionally given up some area of technology found in the claims as filed, the applicant respectfully request that the rejection under 35 U.S.C. 251 be withdrawn.

It is recognized that the PTO urged in the Final Office Action of the parent reissue application, that:

“The Examiner does not agree with applicant that it is unclear from the prosecution record of the patented application that the claims were amended to overcome the prior art of record. The Interview Summary 11/14/95 specifically states that the prior art of record fails to teach or suggest the structural features of claims 5 and 8, implying that it was the Examiners opinion that the prior art taught or suggested the features of claim 1. The Interview Summary offers no others reason for amending the claims and the record shows that applicant approved the amendment. Therefore, in the Examiners opinion, the record is clear that claim 1 was amended by adding the structural feature of claims 5 and 8 to be distinguished from the prior art cited.”

It is apparent that the Examiner in that instance did specifically note that the prior art of record did not teach the noted features. It is good PTO practice to state why claims are patentable. However, an Examiner's stating that prior art not cited against a claim doesn't render that amended claim unpatentable does not, at the same time, raise the comment to the level of a rejection against the unamended claim. It is just as possible that the Examiner there thought the claims to be “too broad” in a judicially impermissible way and wished only to avoid an argument by making an offer to “take” claims that had additional limitations in them. Without a statement about the unpatentability of the claims, no such inference is permissible.

Withdrawal of the rejection is requested.

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Reference to the Co-pending Parent Application

Reference to the co-pending parent application has been added in the above amendment as requested by the Examiner. Therefore, the applicants respectfully request the withdrawal of the objection that was base on lack of reference to the co-pending parent application.

35 U.S.C. §102 Rejections

(i) EP 0 585 933 A2

Claims 14 and 18 stand rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 585 933 A2. In support of the rejection, the Examiner indicates:

“The reference discloses a system comprising of planar electrode which enables easy multipoint simultaneous stimulation and measurement of nerve cells as well as signal transmission and observation throughout many cells. See the abstract and figures 2.”

The published patent application EP 0 585 933 A2 is not available as a reference against these claims under 35 USC 102(b) since it was published on March 9, 1994. This application carries a U.S. initial filing date of June 5, 1995 (the filing date of the '067 patent) and a priority date under 35 USC 119 (granted by the USPTO in that parent patent) of June 13, 1994. Since there is less than a year between the dates, 35 USC 102(b) does not provide a patentability bar.

Withdrawal of the rejection is requested.

(ii) Novak, Journal of Neuroscience Methods

Claims 14-23 stand rejected under 35 U.S.C. 102(b) as anticipated by *Novak et al.*, *Journal of Neuroscience Methods*, 23 (1998). In support of the rejection, the Examiner notes:

“The *Novak et al.* reference discloses a 32 element microelectrode array for stimulation of hippocampal cells and recording of the response. Figure 1 shows the planar substrate with electrodes with corresponding pathways. “Figure 5 shows the display of cells in response to electrode stimulation.”

Applicants disagree. It remains not apparent from a reading of *Novak et al.* that the device described there is able to provide a stimulus from more than a single array member and further that the site used as a stimulus is also able to record as well. Again, please note the under the title “Stimulation with the Array” at page 151 that the “responses evoked using array stimulation were recorded using a glass micropipette electrode.” This does not meet the terms of the claims.

Said in another way, *Novak* teaches the use of a “separate” electrode with independent connection, in conjunction with the planner electrode array for measurement of cell potentials. As the Examiner noted, the *Novak* device “may be used for stimulation as well as recording”. However, the Office Action overlooks the fact that *Novak* actually suggests the use of electrode array for stimulation “or” recording, and does not suggest the use of the array as stimulating “and” recording electrodes at the same time. In the two experiments described in *Novak*, the

array was used “either” as the stimulating electrode or as the recording electrode, and in both experiments a separate electrode was needed to compliment the electrode array for cell potential measurements.

To expand: In the first experiment, where the electrode array was used as the recording electrode, a separate bipolar stainless steel electrode was used as the stimulating electrode (*Novak*, page 150, second column, second to last paragraph). In the second experiment, where the electrode array was used as the stimulation electrode, a separate 3 M NaCl filled glass micropipette was used as the recording electrode (*Novak*, page 151, second column, second to last paragraph).

In addition, the *Novak* article specifically teaches away from the use of electrode array as the stimulating and recording electrode at the same time. First, the article describe the suppression of the input current, in effect isolating the electronics for current measurement from the array electrodes during the stimulus (*Novak*, Figure 1-B description). Second, the circuit connected to the array does not provide for supply of a stimulation signal, thus requiring a separate electrode and electronic circuitry to provide the stimulating electric current (*Novak*, Figure 1-B).

On the other hand, Claim 14 specifically requires a signal processor connectable to the connective pathways for the processing of the measured signal, and a stimulation signal supply, also connectable to the connective pathways, for providing electrical stimulation. Thus, the electrode array in the claimed invention described in Claim 14 serves both as the measuring and the stimulating electrodes.

Since *Novak* fails to disclose each of the elements of Claim 14, *Novak* does not anticipate Claim 14 nor any of the claims depending from claim 14. Applicants respectfully request that the rejection under § 102(b) be withdrawn.



CONCLUSION

Applicant has replied to each matter of substance raised in the Office Action.

Reconsideration and allowance of the pending claims are respectfully requested. If a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

Dated: June 3, 2002

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- c: i.) Consent Under 37 CFR 1.172 by Assignee.....
ii) Assignment

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Please insert at column 1, line 4, the first line of the specification the following:

Application 09/688,077 filed October 13, 2000 and co-pending Application 09/169,188,
filed October 8, 1988, are each reissues of U.S. Patent No. 5,563,067 (Application No.
08/464,116), filed June 5, 1995.

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